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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/768,878	01/23/2001	Graham Wolstenholme	MI55-003	4402

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SPOKANE, WA 99201-3828

EXAMINER
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BOOTH, RICHARD A

ART UNIT	PAPER NUMBER
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2812

DATE MAILED: 05/13/2002

12

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/768,878

Applicant(s)

WOLSTENHOLME, GRAHAM

Examiner

Richard A. Booth

Art Unit

2812

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 01 May 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 24-31, 36, 37, 39-41 and 45-54 is/are pending in the application.
- 4a) Of the above claim(s) 39 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 24-31 and 45-53 is/are allowed.
- 6) ☒ Claim(s) 36, 37, 40, 41 and 54 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 5-1-02 has been entered.

### ***Specification***

The amendments filed 2-4-02 and 5-1-02 are objected to under 35 U.S.C. 132 because they introduce new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: the objection to the amendment filed 2-4-02 is maintained. Furthermore, the amendment filed 5-1-02 adds new matter into the specification because stating that "not shown" items are shown in the embodiment of Figs. 7-9 is new matter since this was never stated before and therefore the not shown layers were not adequately described to be shown in Figures 7-9 in the specification as originally filed.

Applicant is required to cancel the new matter in the reply to this Office Action.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 36-37, 40-41, and 54 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The rejection is maintained as stated in the paper mailed 3-29-02 with respect to claims 36-37 and 40-41 for the reasons of record.

***Response to Arguments***

Applicant's arguments filed 5-1-02 have been fully considered but they are not persuasive. First, the examiner wishes to emphasize to applicant that each and every argument made in previous office actions has been given consideration and has not been overlooked. The portion of the specification relied upon to show the "insulating cap" is not persuasive to overcome the objections under 35 USC 132 and the rejections under 35 USC 112, first paragraph for a variety of reasons which will be explained in detail below.

First, the portions of the specification relied upon for support of the insulating cap are describing another embodiment and not the embodiment being claimed by applicant. Secondly, this portion of the specification, even if relied upon with respect to

Figure 7, fails to provide support for the insulating cap being the uppermost layer. For example, the specification states that "Lines of floating gates 12 and 14 preferably constitute a gate dielectric layer, floating gate regions 23, an interpoly dielectric layer, a conductively doped polysilicon/silicide stack, and an insulative cap". Figure 7 shows a total of six distinct regions in floating gates 12 and 14 while the above mentioned sentence only describes five regions. Therefore, it is not clear to one of ordinary skill in the art even if the above mentioned portion of the specification is taken as to provide support for a completely different embodiment (the embodiment of Figures 7-9), whether the uppermost layer of the stack is an insulative cap because the layers are not described with sufficient specificity as to allow one of ordinary skill in the art to determine what the uppermost layer is. These two arguments form the basis for the examiner's above mentioned rejections and objections. With respect to applicant's additional argument that if the uppermost layer is not the insulative cap then the device is inoperable, the examiner does not agree with this statement. For example, the uppermost layer could be conductive and the second layer from the top could be insulative and in this instance the device would not be inoperable. The fact that applicant has not described the embodiments of Figures 7-9 with sufficient specificity does not allow the examiner to begin making assumptions about what layers are or are not shown. The layers must be described in the specification to allow one of ordinary skill in the art to make a determination as to what the layers are or are not.

***Allowable Subject Matter***

Claims 24-31 and 45-53 are allowed.

***Conclusion***

This is a RCE of applicant's earlier Application No. 09/768,878. All claims are drawn to the same invention claimed in the earlier application and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the earlier application. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action in this case. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no, however, event will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Richard A. Booth whose telephone number is 308-3446. The examiner can normally be reached on Monday-Thursday from 7:30-6:00.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Niebling can be reached on 308-3325. The fax phone numbers for the organization where this application or proceeding is assigned are 308-7724 for regular communications and 308-7724 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 308-1782.

A handwritten signature in black ink, appearing to read 'Richard A. Booth', is positioned above the printed name.

Richard A. Booth  
Primary Examiner  
Art Unit 2812